

Remarks

Claims 1-6 and 8-18 are pending in the application. Claim 7 has been canceled above without prejudice to or disclaimer of the subject matter therein. Claims 1-6 and 8-18 stand rejected. Favorable reconsideration is respectfully requested.

The drawings were objected to. Withdrawal of the objection is respectfully requested in view of the new figures, FIGs. 9 and 10, submitted herewith, the corresponding amendments to the specification, and the cancellation of claim 7 reciting a heat sink connector. The Applicant respectfully requests entry of the new figures. No new matter has been added.

Claims 16 and 17 were rejected as anticipated by Sangveraphunsiri (U.S. 5,530,620). To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). In view of the foregoing authority, the Applicant respectfully submits that the cited reference fails to support the asserted rejection.

Claim 16 requires "inserting the edge connector of said processor in a connector on said motherboard, said processor having an orientation parallel ..." (Emphasis supplied). In Sangveraphunsiri, Figs. 21 and 22 illustrate inserting the module into the bay of a disk drive which has a connector therein. Thus, the connector is not "on said motherboard." In Fig. 20, the connector is on the motherboard but the processor is not "parallel." Thus, Sangveraphunsiri does not anticipate claim 16, nor claim 17 dependent thereon. Withdrawal of the rejection of claims 16 and 17 as anticipated by Sangveraphunsiri is therefore respectfully requested.

Claims 1, 2, 4, 5, 12, 14 and 18 were rejected under 35 USC 103(a) as being unpatentable over Buras, Jr et al. ("Buras") (US 5,559,672) in view of Anderson (U.S. 5,898,869). To establish a prima facie case of obviousness under § 103, all claim limitations of a claimed invention must be taught or suggested by the prior art. See MPEP, Section 2143.03 and In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In view of at least the foregoing authority, the Applicant respectfully submits that the cited references do not support the asserted rejection, as discussed below.

Each of independent claims 1, 12, 14, 16 and 18 recites a mount for a *cartridge processor* to hold the cartridge processor parallel to and displaced from a motherboard. The Examiner acknowledges that the primary reference Buras does not teach or suggest a processor, but cites Anderson as teaching a PCMCIA card that includes a processor, and alleges that it "would have been obvious ... for the cartridge ... of Buras ... to be a cartridge processor and/or a processor as taught by Anderson to expand the computer processing capabilities" (Office Action, p. 5, lines 6-9).

The Applicant respectfully disagrees with both the facts assumed by the Examiner and the Examiner's conclusion based thereon. The Applicant submits that the Examiner has overlooked the fact that the primary reference Buras does not, in reality, teach or suggest a cartridge -- this has simply been assumed by the Examiner. Notably, a "PCMCIA card" as shown in Buras and Anderson is not a *cartridge* as required by the present claims. The following is from a search on the term "PCMCIA card" on the Web site "whatis.com" (a popular source of definitions of technical terms, especially in the information technology field): "A PCMCIA card is a credit card-size memory or I/O device that connects to a personal computer, usually a notebook or laptop computer. Probably the most common example of a PCMCIA card is the 28.8 Kbps modem for notebook computers." More generally, the Applicant submits, a "card" is understood to be some form of a printed circuit board, which is typically a thin, lightweight structure without any external casing.

By contrast, a cartridge as claimed is a more substantial structure. As disclosed in the present specification at, for example, page 7, lines 21-23, a cartridge processor as claimed includes an SECC casing 48, a connector 46, and guide rails 43 and 45. It is further disclosed in the present specification that comparable structures in the prior art, e.g., processor 10 as shown in FIG. 1, required complex retention arrangements, as described in the present specification at page 3, lines 9-25.

Thus, a *prima facie* case of obviousness is not supported for at least the reason that neither Buras nor Anderson suggests a cartridge processor. Other authority is also

countervailing to the Examiner's position. For example, it is well-established that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Furthermore, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Here, there is no suggestion for the modification to Buras in view of Anderson proposed by the Examiner. Instead, as noted above, the art as a whole teaches away from this. More specifically, the Applicant respectfully submits that one of ordinary skill in the field to which the present invention relates would not look to Buras and, in light of Anderson, find a suggestion to replace the PCMCIA card thereof with a cartridge processor, since the prior art, to the contrary, suggests that that the retention structures of Buras would be inadequate therefor. Instead, a teaching of a cartridge processor mounted as required by the present claims can only be found by recourse to the Applicant's disclosure. However, the latter involves the impermissible use of hindsight reconstruction.

In view of the above, the independent claims, and consequently the claims dependent thereon, are allowable over Buras and Anderson. Accordingly, withdrawal of the rejection of claims 1, 2, 4, 5, 12, 14 and 18 as being unpatentable over Buras and Anderson is respectfully requested.

Claims 3, 13, and 15 were rejected as being unpatentable over Buras and Anderson, and further in view of Hyde et al. (US 5,751,514). Claim 6 was rejected as being unpatentable over Buras and Anderson, and further in view of Pierson et al. (US 5,889,654). Claim 7 was rejected as being unpatentable over Buras and Anderson, and further in view of Feightner et al. (US 5,748,446). Claims 8-10 were rejected as being unpatentable over Buras and Anderson, and further in view of Karidis et al. (US

5,793,607).). Claim 11 was rejected as being unpatentable over Buras, Anderson, Karidis et al., and further in view of Sangveraphunsiri.

Each of claims 3, 6, and 7-11 is a dependent claim, and as such includes the features of one of the independent claims. The independent claims are allowable over Buras and Anderson as discussed above, for at least the reason that Buras and Anderson do not teach or suggest a mount for a cartridge processor to hold the cartridge processor parallel to and displaced from a motherboard, as required by the independent claims. Moreover, none of Pierson et al., Feightner et al. , Karidis et al. or Sangveraphunrasi remedies the aforementioned deficiencies in Buras and Anderson. Accordingly, the independent claims are also allowable over the cited combinations of references. Therefore, the dependent claims are likewise allowable over the cited combinations for at least the reason that they include the features of one of the independent claims. Withdrawal of the rejection of claims 3, 6, and 7-11 is therefore respectfully requested.

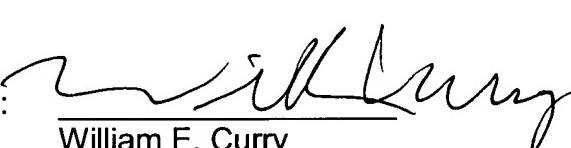
In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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